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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,637	11/09/1999	TAKAHISA NITTA	1776/044	6921

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EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/436,637

Applicant(s)

Nitta et al.

Examiner

Charles Cooley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 MAR 2003 and 7 MAY 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above, claim(s) 16-62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 63 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction<sup>5</sup> filed on 10/3/02 & 3/10/03 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## OFFICE ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 MAR 2003 has been entered.

### *Election/Restriction*

2. Claims 16-61 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 9.

### *Priority*

3. Acknowledgment is made of applicant's claim for priority based on three Japanese applications. It is noted, however, that applicant has not filed certified copies of the applications as required by 35 U.S.C. § 119. The letter of 14 FEB 2000 regarding the priority documents is noted, however, the original priority documents are not in the file wrapper. Applicant states copies of the missing priority documents were

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submitted with the last response filed 03 OCT 2002, yet the file still lacks the documents. Applicant has agreed to submit the priority documents prior to payment of the issue fee.

### ***Drawings***

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 03 OCT 2002 10 MAR 2003 have been approved by the Examiner.

### ***Specification***

5. The abstract is acceptable.
6. The title is acceptable.

### ***Claim Rejections - 35 U.S.C. § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claim 63 is rejected under 35 U.S.C. § 102(e) as being anticipated by Hashimoto et al. (USP 5,918,976).

The patent to Hashimoto et al. (USP 5,918,976) discloses a chemical mixing system comprising a chemical reservoir 16; chemical supply means 15; a piping system (as seen in Figs. 1-2) with a discharge portion 25; and a chemical discharging means 14 arranged to discharge material from the chemical supply means 15 into the piping system.

9. Claim 63 is rejected under 35 U.S.C. § 102(b) as being anticipated by Rodgers et al. (USP 4,664,528).

The patent to Rodgers et al. (USP 4,664,528) discloses a chemical mixing system comprising a chemical reservoir 7; chemical supply means 10; a piping system (as seen in Fig. 1) with a discharge portion 28; and a chemical discharging means 13 or 19 arranged to discharge material from the chemical supply means 10 into the piping system.

10. Claim 63 is rejected under 35 U.S.C. § 102(b) as being anticipated by Cadeo et al. (USP 4,964,732).

The patent to Cadeo et al. (USP 4,964,732) discloses a chemical mixing system comprising a chemical reservoir 1; chemical supply means 5; a piping system (as seen in Fig. 3) with a discharge portion (downstream of 20); and a chemical discharging means 15 arranged to discharge material from the chemical supply means 15 into the piping system.

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11. Claim 63 is rejected under 35 U.S.C. § 102(b) as being anticipated by O'Dougherty et al. (USP 5,522,660).

The patent to O'Dougherty et al. (USP 5,522,660) discloses a chemical mixing system comprising a chemical reservoir 23; chemical supply means 20; a piping system (as seen in Fig. 1) with a discharge portion 56; and a chemical discharging means 31 arranged to discharge material from the chemical supply means 20 into the piping system.

#### ***Allowable Subject Matter***

12. Claims 1-15 are allowable over the prior art of record for the reasons advanced by Applicant in the response filed 10 MAR 2003 and because claim 1, as amended, is deemed to invoke 35 USC 112, sixth paragraph with regard to the "chemical supply means" and "chemical discharging means". The subject matter related to the "chemical discharging means" is supported at page 26 of the specification and the examiner considers the phrase "significantly larger" to be defined as velocities which differ at a factor of about ten as disclosed by the instant specification.

#### ***Response to Amendment***

13. Applicant's arguments filed 10 MAR 2003 with respect to claim 63 have been fully considered but they are not deemed to be persuasive.

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Applicant argues the intended use set forth in claim 63 is lacking from the prior art. However, such an intended use has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641.

The claim language in claim 63 "for cleaning a substrate" is merely a statement of intended use which imparts no structure to the claimed apparatus. It is well settled that the intended use of an apparatus is not germane to its patentability. *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982); *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967).

Nonetheless, the patent to Ferri, Jr. et al. '599 teaches a system for producing a mixture which is delivered to downstream facilities adapted for cleaning (polishing) a substrate such as semiconductor wafers.

### **Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles Cooley whose telephone number is ☐ (703) 308-0112.

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15. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is ☎ (703) 308-0651.



Dated: 10 July 2003

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**Charles Cooley**  
**Primary Examiner**  
**Art Unit 1723**